

regard as the invention, on the grounds of multiplicity. In support of this contention, the Examiner cited M.P.E.P. § 2173.05(n), stating that:

[a]n unreasonable number of claims, that is, unreasonable in view of the nature and scope of Applicant's invention and the state of the art, may afford a basis for a rejection on the ground of multiplicity. A rejection on this ground should include all the claims in the case inasmuch as it related to confusion of the issue.

M.P.E.P. § 2173.05(n). Relying on this, the Examiner stated that Applicants "*should* select" 50 claims for the purposes of examination. Applicants, believing that the language "*should* select" was not a requirement, chose not to elect 50 claims for examination. In the reply mailed May 24, 2001, the Examiner held that the response was non-responsive and that Applicants "[m]ust select the required number of claims indicated by the Examiner." After discussing this issue with the Examiner's supervisor, Gary Kunz, Applicants maintain their position and respectfully disagree with the Examiner's reasoning and traverse this rejection.

MPEP § 2173.05(n) cites *In re Wakefield* to show that while a large number of claims may be tedious to examine, "this is no reason for saying that the invention is obscured by the large number of claims," which fully supports Applicants position. This Court further explains:

[a]n applicant often does not know all the prior art which may be asserted against his broader claims when he litigates his patent. Further, he is never sure that the broader claims will not be successfully attacked on other grounds when litigated in the courts . . . For these reasons, an applicant should be allowed to determine the necessary number and scope of his claims, provided he pays the required fees and otherwise complies with the statute.

In re Wakefield, 422 F.2d 897, 901. Applicants are not aware of any statutory requirements that require Applicants to limit the number of claims to 50. Applicants have also paid the required fees for prosecuting the pending claims. Thus, Applicants have followed permissible caselaw and statutory requirements and merely added a prudent set of claims of a different scope by which to protect their invention. Applicants respectfully request that the Examiner withdraw the rejection of claims 33-400.

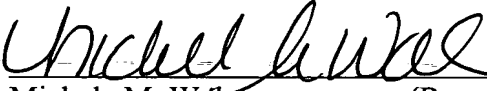
Conclusion

In view of the foregoing remarks Applicants believe they have fully addressed the Examiner's concerns and that this application is now in condition for allowance. An early notice to that effect is urged. A request is made to the Examiner to call the undersigned at the phone number provided below if any further action by Applicants would expedite allowance of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: 9/12/01


Michele M. Wales (Reg. No. 43,975)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Telephone: (301) 610-5772

Enclosure
MW/AKE/lcc